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10/646,215

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,215

Applicant(s)

INOUE ET AL.

Examiner

KELLY CAMPEN

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15,17-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The following is in response to the amendments and arguments filed 10/9/2008.

Claims 1,3-8,10-15,17-19,21-25 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-7 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 3-7, and 22 recite a process comprising the steps of receiving, detecting, determining, outputting, and recording. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The storing in a database is a nominal tie to a class and therefore not sufficient for the purposes of 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3-8, 10-15, 17-19, 21-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Kensuke et al. (JP 2002-109419) as applied in the prior office action.

Specifically as to claim 1, Kensuke et al. disclose a computer-implemented method of facilitating e-commerce transactions, the method comprising: receiving a settlement request for a purchase account and related information sent from an end user system used by an end user to make a purchase from a seller or sent from a store system used by the seller, the related information including a purchase price of the purchase and an identifier of the end user[0013-0015]; detecting whether an account system of a financial institution is in operation, wherein the account system is where the end user has an account that is appointed for settlement of the settlement request; if it is detected that the account system is in operation, executing a settlement procedure, including transferring an amount of money to pay from the end user's account to the seller's account; and if it is detected the account system is not in operation, executing an automatic financing procedure comprising the steps of : determining whether the purchase account of the settlement request can be financed , based on financing availability information which specifies a financing available amount of the end user, and the purchase price of the purchase[0016]; and if it is determined that the purchase account can be financed , then outputting a message that the purchase account can be settled

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through financing; and recording financing information regarding a charge account of the end user for the purchase, the charge account being determined based on the purchase price of the purchase (see paragraphs [0014]-[0019]).

Specifically as to claims 3, 10 and 17, receiving the financing availability information of the end user from the account system at predetermined intervals and replacing the financing availability information stored in a data processing system by the received financing availability information [0019, 0035].

Specifically as to claims 4, 11, 18 and 21, sending the recorded financing information to the account system of the end user at predetermined intervals [0014].

Specifically as to claims 5 and 13, receiving a maximum allowable financing information which specifies a value up to which the end user is allowed to get financing as the financing availability information and a charge account information which specifies a remaining charge account of the end user from the account system of the end user; and determining whether the purchase account can be settled through financing, based on the received maximum allowable financing information and charge account information [0034-0035].

Specifically as to claim 6 and 14, wherein it is determined that the purchase account can be settled through financing if a value obtained by subtracting the amount of money specified by the charge account information and the purchase price of the purchase from a value specified by the maximum allowable financing information is not less than 0 [0034].

Specifically as to claim 7, 12, and 21, wherein the maximum allowable financing information and the charge account information are received from the account system at predetermined intervals [0014, drawing 1].

Specifically as to claim 8, an apparatus for facilitating e-commerce transaction to which an end user system which is used by an end user to make a purchase from a seller and a store system used by the seller are connected via a network, the system comprising: a receiver coupled with the network to receive a settlement request for a purchase account and related information sent from an end user system used by an end user to make a purchase from a seller or sent from a store system used by the seller, the related information including a purchase price of the purchase and an identifier of the end user; a processor coupled with the receiver[0013-0015]; and a memory storing a program including a plurality of code modules which are executable by the processor, the plurality of code modules including; a code module for determining whether the purchase account of the settlement request can be settled through financing, based on financing availability information which specifies financing available amount of the end user, and the purchase price of the purchase a detecting module configured to detect whether an account system of a financial institution is in operation, wherein the account system is where the end user has an account that is appointed for settlement of the settlement request[0016]; an executing module configured to execute a settlement procedure by the account system, including transferring an amount of money to pay from the end user's account to the seller's account, if it is detected that the account system is in operation; and the executing module configured to execute an automatic financing procedure, if it is detected the account system is not in operation; wherein the executing of the financing

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procedure includes utilizing a code module for outputting a message that the purchase account can be settled through financing upon determining that the purchase account can be settled; a code module for recording financing information regarding a charge account of the end user for the purchase upon determining that the purchase account can be settled, the charge account being determined based on the purchase price of the purchase [0014-0019].

Specifically as to claim 15, an apparatus for facilitating e-commerce transaction to which an end user system which is used by an end user to make a purchase from a seller and a store system used by the seller are connected via a network, the system comprising: means for receiving a settlement request for a purchase account and related information sent from an end user system used by an end user to make a purchase from a seller or sent from a store system used by the seller, the related information including a purchase price of the purchase and an identifier of the end user[0013-0014]; means for detecting whether an account system of a financial institution is in operation, wherein the account system is where the end user has an account that is appointed for settlement of the settlement request[0015]; if it is detected that the account system is in operation, means for executing a settlement procedure, including transferring an amount of money to pay from the end user's account to the seller's account; and if it is detected the account system is not in operation, means for executing an automatic financing procedure, wherein the execution of the automatic financing procedure includes: means for determining whether the purchase account of the settlement request can be financed settled through financing, based on financing availability information which specifies financing available amount of the end user, and the purchase price of the purchase[0016]; if it is

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determined that the purchase account can be financed, then: means for outputting a message that the purchase account can be settled through financing upon determining that the purchase account can be financed and means for recording financing information regarding a charge account of the end user for the purchase upon determining that the purchase account can be settled, the charge account being determined based on the purchase price of the purchase[0014-0019].

Specifically as to claim 19, In a computer readable medium storing a program for facilitating e-commerce transaction to which an end user system which is used by an end user to make a purchase from a seller and a store system used by the seller are connected via a network, the program comprising: code for receiving a settlement request for a purchase account and related information sent from an end user system used by an end user to make a purchase from a seller or sent from a store system used by the seller, the related information including a purchase price of the purchase and an identifier of the end user; code for detecting whether an account system of a financial institution is available, wherein the account system is where the end user has an account that is appointed for settlement of the settlement request; if it is detected that the account system is in operation, code for executing a settlement procedure, including transferring an amount of money to pay from the end user's account to the seller's account; and; if it is detected the account system is not in operation, code for executing an automatic financing procedure, wherein the execution of the automatic financing procedure includes: code for determining whether the purchase account of the settlement request can be financed through financing, based on financing availability information which specifies financing available amount of the end user, and the purchase price of the purchase; if it is

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determined that the purchase account can be financed, then: code for outputting a message that the purchase account can be settled through financing upon determining that the purchase account can be financed and code for recording financing information regarding a charge account of the end user for the purchase upon determining that the purchase account can be settled, the charge account being determined based on the purchase price of the purchase (see above rejections and citation for claims 1 and 15).

Specifically as to claims 22, 23, 24 and 25, wherein the detecting of whether the account system of the financial institution is available is based on an on/off status table (see drawing 2, paragraph [009]), wherein the on/off status table includes a table entry corresponding to each banking institution which includes an on/off Boolean indicator associated with each of banking institutions to indicate the banking institution's account system's availability (see paragraphs [0013-0015]).

Response to Arguments

Applicant's arguments filed 10/09/2008 have been fully considered but they are not persuasive.

With regards to applicant's arguments to the 35 USC 101 rejections, the amendments have not overcome the rejection. As stated above, to qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The storing in a database is a nominal tie to a class and therefore not sufficient for the purposes of 35 USC 101.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specifically, "storing the financing availability information in a separate location from the accounting system, such that when the accounting system is not available, the financing availability information is still accessible by the central equipment and financing can still occur") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regards to applicant's argument that Kensuke fails to disclose financing availability information, Examiner disagrees. The system of Kensuke is capable of performing this function. In addition, applicant's argument that the central equipment "can" execute the automatic financing based on the financing availability information when the bank is unavailable is not possible in Kensuke, Examiner disagrees. The system of Kensuke inherently determines if the computer system is in operation, as it determines whether or not the account can be settled, which can only inherently occur if the system is in operation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/

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Primary Examiner, Art Unit 3691